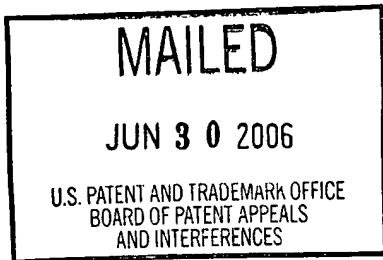


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte DWAYNE LACEY

Appeal No. 2006-1504
Application No. 09/935,297
Technology Center 3700

HEARD: June 8, 2006

Before FRANKFORT, BAHR and NAPPI, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-4 and 6-33.

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION.

BACKGROUND

The appellant's invention relates to a head massaging device. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following as evidence of anticipation and obviousness in rejecting the claims on appeal.

Rowe	836,217	Nov. 20, 1906
Erickson	2,113,444	Apr. 5, 1938
Blachly	3,585,990	Jun. 22, 1971
Rabin	5,421,799	Jun. 6, 1995
Taylor	5,611,771	Mar. 18, 1997
Lacey	AU-S-134633	August 12, 1998
Robbins	6,450,980 B1	Sep. 17, 2002 (Jul. 21, 2000)

The following rejections are before us for review.

- (1) Claims 1, 2, 7, 15-17, 23, 26, 27 and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rabin.
- (2) Claims 1-3, 7-10, 15-19, 23 and 26-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Taylor.
- (3) Claims 1-4 and 6-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Robbins in view of Rabin or Blachly.
- (4) Claims 1, 4, 6-8, 10, 13-17, 19, 22-27 and 30-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Erickson in view of Rabin.
- (5) Claim 33 stands rejected under 35 U.S.C. § 103 as being unpatentable over Erickson in view of Rabin and Rowe.
- (6) Claims 1-4 and 6-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lacey in view of Rabin or Blachly. This is a new ground of rejection entered in the examiner's answer (mailed November 3, 2005), pursuant to 37 CFR § 41.39(b).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer for the examiner's

complete reasoning in support of the rejections and to the appellant's brief (filed December 27, 2004) and reply brief (filed May 31, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the following determinations.

We turn our attention first to the rejection of claims 1, 2, 7, 15-17, 23, 26, 27 and 29 as being anticipated by Rabin. Rabin discloses a scalp massager including a main supporting frame 12 capable of being stretched into an arc, as illustrated in Figure 1, for receiving a person's head and being resiliently biased to curl up on itself when at rest as shown in Figure 8. The frame 12 thus has an inherent bias when placed on a human head tending to hold it onto the human head.

The main frame 12 has a front end including a slot 14 accommodating a wing nut fastener 18 and a rear end including a hole that accommodates a wing nut fastener 16. A vibration generating apparatus, including an electrical motor 28 and an off-center weight mechanism, is mounted on the frame 12 between the fasteners 16, 18 for imparting vibration to the frame 12, which vibration is transmitted to a temporal crosspiece 30 and an occiput crosspiece 32.

The appellant argues, on pages 11 and 12 of the brief, that Rabin does not disclose a plurality of resilient fingers each having a free end and an opposite end and shaped such that in use, when the device is lowered onto the head so that the head enters through an opening defined by the juxtaposition of the free ends of the fingers, the free ends of the fingers apply pressure to and massage the head, as recited in the appellant's claims. For the following reasons, this argument is not well taken.

The examiner finds that the frame 12, temporal crosspiece 30 and occiput crosspiece 32 respond to the plurality of resilient fingers of appellant's claims. We agree. We note, in this

regard, that the claims do not require that the fingers be physically discrete elements or exclude fingers that are integrally or unitarily coupled or fixed to one another at their opposite ends. Further, while claims 1 and 23 recite that the opposite ends of the fingers are coupled together, the claims do not require that the opposite ends be directly coupled together. The frame 12 can reasonably be viewed as being made up of a rear finger and a front finger coupled together at the center of the frame 12 and thus fully responds, itself, to the “plurality of resilient fingers” having free ends and opposite ends coupled together. Moreover, each of the crosspieces can likewise reasonably be viewed as two additional fingers coupled together at “opposite ends” (at the center of each crosspiece), which opposite ends are coupled, through the frame 12, to the vibrating device and to the opposite ends at which the front and rear fingers of the frame 12 meet (i.e., the center of the frame 12).

That the frame and crosspieces of Rabin form a “head-receiving space” is quite apparent from Figures 1-5. Moreover, in its curled up rest state, as shown in Figure 8, the head-receiving space has a circumference that exceeds that of the opening formed by the front and rear ends of the frame 12 and the opening is smaller than the human head. As Rabin’s scalp massager is stretched over the head of the user and the massager is lowered onto said head so that the head enters the head-receiving space, the free (front and rear) ends of the frame apply pressure to and thus, at least to some degree, massage the head, by virtue of the inherent bias of the frame 12 described above.

In light of the above, we do not find the appellant’s arguments persuasive of any error on the part of the examiner in rejecting claims 1, 2, 7, 23, 26, 27 and 29 as being anticipated by Rabin. The rejection of these claims is sustained.

The rejection of claims 15-17 as being anticipated by Rabin, however, is not sustained. Claim 15, from which claims 16 and 17 depend, recites “each of said fingers having a transversely extending portion ... followed by a contiguous portion extending downwardly and inwardly from said transversely extending portion.” This limitation is not met by Rabin.

The rejection of claims 1-3, 7-10, 15-19, 23 and 26-29 as being anticipated by Taylor is not sustained. Taylor's apparatus does not include a plurality of fingers defining an opening and a head-receiving space meeting the requirements set forth in the appellant's claims. In particular, there are no elements (fingers) of Taylor's apparatus that define a head-receiving space having a circumference that exceeds the circumference of an opening defined by free ends of such elements through which a head passes as the apparatus is lowered onto such person's head. The extension fingers 16, 16' and the leg portions 20, 20' of the headset define a head-receiving space, but the free ends of the extension fingers 16, 16' considered by the examiner to respond to the "fingers" of the claims do not define an opening through which the user's head enters the head-receiving space. Rather, the leg portions 20, 20', and to some extent the inside surfaces of the fingers 16, 16', define the opening. While the headset assembly is disclosed as being "semi-flexible," there is no indication that the leg portions 20, 20' thereof are or can be bent inwardly to form a head-receiving space having a circumference exceeding that of the opening defined by the lower ends of such leg portions.

We turn our attention next to the rejection of claims 1-4 and 6-33 as being unpatentable over Robbins in view of Rabin or Blachly. Robbins discloses a head or scalp massage device including a handle 10 and a plurality of flexible, elongated prongs or fingers 22, 24, 26, 28 protruding from the handle. Robbins describes the prongs or fingers as "preferably sufficiently stiff as to retain their position and shape" and "somewhat resilient, inasmuch as they will return to their initial positions after application of a force thereto less than a bending force" (col. 2, last para.). Upon application of a force sufficient to cause bending, the prongs or fingers will stay in that bent shape. As shown in Figure 1, each of the prongs or fingers has a covering 30 at its tip to protect the scalp against injury or damage.

The appellant argues, on page 6 of the brief, that Robbins lacks disclosure that the fingers are configured to define a head-receiving space and to have an opening as recited in the claims. We do not agree. We first observe that the claims do not require that the entirety of the head be

received within the head-receiving space defined by the fingers. Given the described resiliency of Robbins' fingers, which may, like the fingers of the appellant's device, be composed of copper or other metal or metal alloy (col. 2, ll. 61-62), the fingers will spread over at least a portion of the scalp and receive a portion of the head in the space therebetween.

The examiner recognizes that Robbins lacks a vibrator coupled to opposite ends of the fingers as required by the appellant's claims. As noted by the examiner, however, the provision of vibrators on head and scalp massagers, to stimulate the scalp, was well known in the art at the time of the appellant's invention, as evidenced by Rabin and Blachly. The examiner's position that it would have been obvious to include a vibrator in the Robbins massage device to enhance the stimulating or massaging effect on the scalp as taught by Rabin or Blachly is well supported.

The appellant argues in the paragraph bridging pages 8 and 9 of the brief that Robbins' mention of the Rabin scalp massager having a helmet-like shape in the background section of the Robbins patent and subsequent reference to problems in the art in providing a device "meeting the above requirements" instructs the reader away from prior art such as that of Rabin. We find in the portions of the Robbins patent referenced by the appellant no such instruction.

The appellant's argument on page 9 of the brief that the use of elongated fingers as disclosed in Robbins would be at odds with the functionality of Blachly because such fingers would simply bend under the force required to remove dandruff is likewise unpersuasive. The examiner's rejection does not propose that the Robbins device be used to remove dandruff. Rather, the examiner's position is that it would have been obvious to modify Robbins to provide a vibrator to enhance the massaging effect of the Robbins device.

In light of the above, the appellant's arguments fail to persuade us of any error on the part of the examiner in rejecting claims 1-4, 6-14 and 23-29 as being unpatentable over Robbins in view of Rabin or Blachly. The rejection of these claims is sustained.

The like rejection of claims 15-22 and 30-33, however, is not sustained. Each of these claims recites each of the fingers having a transversely extending portion immediately adjacent

the handle followed by a contiguous portion extending downwardly and inwardly from the transversely extending portion. Robbins does not disclose fingers having such a shape. While the fingers of Robbins are very probably capable of being bent into such a configuration, there is no specific suggestion in Robbins or Rabin or Blachly to do so. Even when the Robbins massage device is applied to the human scalp, there is no indication that the fingers will be flexed or bent into such a configuration.

We turn next to the rejection of claims 1, 4, 6-8, 10, 13-17, 19, 22-27 and 30-32 as being unpatentable over Erickson in view of Rabin. This rejection cannot be sustained. Each of these claims requires that at least a portion of the head-receiving space have a circumference which exceeds that of the opening formed by a juxtaposition of the free ends of the fingers. Erickson's scalp massaging apparatus S, as illustrated in Figures 2 and 3, has its largest circumference at the opening defined by the ends of the fingers 19 and thus lacks a portion of the head-receiving space having a circumference exceeding the circumference at said opening. Rabin's scalp massager, with its frame having a bias so as to curl up on itself, provides absolutely no support for the examiner's determination (answer, p. 6) that it would have been obvious to one of ordinary skill in the art to extend the fingers 19 of Erickson around the head with the ends curving inwardly to "provide a more complete coverage of the person's head."

The examiner's additional reliance on the teachings of Rowe provides no cure for the deficiency of the combination of Erickson in view of Rabin discussed above. It thus follows that the rejection of claim 33 cannot be sustained.

Finally, we turn our attention to the rejection of claims 1-4 and 6-33 as being unpatentable over Lacey in view of Rabin or Blachly. The appellant does not contest the examiner's position that it would have been obvious to modify Lacey to include a vibrator as taught by Rabin or Blachly to enhance the massaging treatment of the head (answer, p. 8). We thus adopt the examiner's position, which is reasonable on its face.

The appellant does argue that Lacey does not disclose that the opening defined by the free ends of the fingers has a circumference which is larger than the circumference of the head of the user (reply brief, p. 10). Be that as it may, none of appellant's claims requires such. On the contrary, claims 1, 7, 15, 23, 26 and 30 recite an opening which is *smaller* than the head.

The appellant also argues that Lacey does not disclose or suggest that the dimensions of the fingers are such that when the device is lowered onto the head of the user, the free ends of the fingers will apply pressure to and thus massage the user's head (reply brief, p. 10). Even without such express disclosure, one of ordinary skill in the art at the time of appellant's invention would have readily understood that the "massage" effect of the device of Lacey's design would be achieved by contact and pressure of the illustrated fingers to the head. Moreover, the photograph attached as Appendix B to appellant's reply brief evidences appellant's concession that the dimensions of the Lacey device are such that when the device is lowered onto the head of the user, the free ends of the fingers will apply pressure to and thus massage the user's head.

The appellant's argument that Lacey does not disclose or suggest that the space defined within the fingers is large enough to receive the head of the user (reply brief, p. 10) is not well taken. We observe, in this regard, that the claims do not require that the entirety of the head of the user be received within the head-receiving space.

The appellant attempts to rely on the two photographs attached as Appendices B and C to illustrate the difference between the Lacey device, which allegedly does not include a head-receiving space, and appellant's device, which the appellant urges does include a head-receiving space. Initially, we note that, although the appellant characterizes the photograph of Appendix B as illustrating the Lacey device, this photograph assumes details, such as dimensions and degree of flexibility, not described in the Lacey design. While the appellant, as the inventor of the Lacey design, may well have contemplated the type and size device illustrated in Appendix B, the appellant has not established that one of ordinary skill in the art at the time of the appellant's invention having reviewed Lacey would have necessarily envisioned such, as opposed to, for

example, a device having fingers of the dimensions and flexibility possessed by the appellant's claimed invention. Moreover, as pointed out above, the appellant's claims do not require any more with respect to a head-receiving space than is illustrated in Appendix B.

The appellant also argues that Lacey does not disclose or suggest that the fingers are resilient, as called for in each of appellant's claims on appeal. While Lacey certainly does not use the term "resilient" in describing the head massage device, all materials are resilient to some degree, in that they possess the ability to recover their size and shape after deformation within the elastic range, with the elastic limits varying from one material to another. Accordingly, any material used for the fingers of the Lacey device would meet the definition of "resilient" offered by the appellant on page 10 of the reply brief. Moreover, the appellant's specification, at page 5, gives some guidance as to the degree and nature of resilience required of the fingers of the invention. According to the specification, "[t]he characteristics of resilience and pliability of the fingers 12 can be achieved by making the fingers 12 from wire." Lacey's illustration of the head massage device shows a plurality of fingers resembling very long thin strands or rods or wires, giving the impression of members of similar resilience.

In light of the above, the appellant's arguments are not persuasive of any error on the part of the examiner in rejecting claims 1-4, 6-8, 10-17, 19-27 and 29-32. The rejection of these claims as being unpatentable over Lacey in view of Rabin or Blachly is thus sustained.

The like rejection of claims 9, 18, 28 and 33, however, is not sustained. Each of these claims recites that the free end of each finger is terminated in a bulb or ball structure neither illustrated nor described in Lacey. The examiner's apparent position (answer, p. 8) that the common inventorship of the Lacey design and the present application can somehow serve to fill the gaps in the description in Lacey with the disclosure in the present application is misguided and unfounded.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection.

Claims 9, 18, 28 and 33 are rejected under 35 U.S.C. § 103 as being unpatentable over Lacey in view of Rabin or Blachly and further in view of Robbins.

As should be evident from our discussion above, we have determined that Lacey meets all of the limitations of claims 9, 18, 28 and 33 with the exception of the vibrator coupled to the opposite ends of the fingers and the free ends of the fingers terminating in a bulb or ball structure. The provision of electric vibrators on head and scalp massagers, to stimulate the scalp, was well known in the art at the time of appellant's invention, as evidenced by Rabin and Blachly. In light of this well known practice, it would have been obvious to one of ordinary skill in the art at the time the appellant's invention was made to provide a vibrator in the handle of Lacey's massage device and coupled to the fingers extending from the handle to transmit vibration to the fingers to stimulate the scalp as taught by Rabin or Blachly and thus enhance the massaging effect of the device.

Robbins teaches providing the ends of fingers of a head or scalp massaging device of the type disclosed by Lacey with bulb or ball shaped coverings, preferably of a soft, resilient plastic coating, to protect the scalp against injury or damage (col. 3, ll. 6-10). This teaching of Robbins would have provided ample suggestion to one of ordinary skill in the art to further modify the device of Lacey to provide such coverings on the ends of the fingers to protect the scalp.

CONCLUSION

To summarize, the rejection of claims 1, 2, 7, 15-17, 23, 26, 27 and 29 as being anticipated by Rabin is affirmed as to claims 1, 2, 7, 23, 26, 27 and 29 and reversed as to claims 15-17; the rejection of claims 1-3, 7-10, 15-19, 23 and 26-29 as being anticipated by Taylor is reversed; the rejection of claims 1-4 and 6-33 as being unpatentable over Robbins in view of Rabin or Blachly is affirmed as to claims 1-4, 6-14 and 23-29 and reversed as to claims 15-22 and 30-33; the rejections of claims 1, 4, 6-8, 10, 13-17, 19, 22-27 and 30-32 as being unpatentable over Erickson in view of Rabin and claim 33 as being unpatentable over Erickson in view of Rabin and Rowe are reversed; and the rejection of claims 1-4 and 6-33 as being unpatentable over Lacey in view of Rabin and Blachly is affirmed as to claims 1-4, 6-8, 10-17, 19-27 and 29-32 and reversed as to claims 9, 18, 28 and 33. A new rejection of claims 9, 18, 28 and 33 is entered pursuant to 37 CFR § 41.50(b).

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 41.59(b)

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge


JENNIFER D. BAHR

JENNIFER D. BAHR
Administrative Patent Judge

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) AND
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